

U.S.S.N. 10/791,247

REMARKS

Traversal of Restriction Requirement

There are several errors in Examiners Restriction Requirement.

Examiners basis for unfairly restricting Applicants to claiming a single species for forming a supercritical fluid to conduct a substrate cleaning process is that "carbon dioxide, methane, ethane, propane, ammonia, nitric oxide, fluoromethane and diflouro methane" "are independent and distinct **because all the species are separately able to clean the substrate by forming a supercritical fluid**".

Firstly, Examiner has provided no basis for the above assertion.

Secondly, Examiner has made no assertion or evidence supplied by Examiner that a search for a supercritical fluid cleaning process including more than one of the listed supercritical fluid species would "present a serious burden on the Examiner" as is required. For example see MPEP 803 et seq.

U.S.S.N. 10/791,247

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

See also the guidelines under section 803 for a proper Restriction Requirement:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) - § 806.04(i)

U.S.S.N. 10/791,247

and § 808.01(a).

Thus, Examiner is required to make out a *prima facie* case that a **serious burden exists** to support a Restriction Requirement. If Examiner fails to make out any case, Applicant is prevented from rebutting such a claim to serious burden as they are entitled to do.

For example, the MPEP as well as the case law sets out requirements for a Markush Group claim (see claim 8):

8. The method of claim 1 wherein said cleaning fluid is selected from the group consisting of methane, ethane, propane, ammonia, nitric oxide, fluoromethane and difluoromethane.

Note that Examiner has included carbon dioxide in claim 4 with the claimed Markush group in claim 8 to require an election to one species, thereby **improperly mixing one separately claimed Species with a Markush group Species**, further limiting Applicants ability to meaningfully respond to the Restriction Requirement.

For example see MPEP 803.02:

803.02 Restriction — Markush Claims

U.S.S.N. 10/791,247

PRACTICE RE MARKUSH-TYPE CLAIMS

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).

Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior

U.S.S.N. 10/791,247

art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

Thus, in addition to **not showing or asserting a serious burden** and preventing Applicants from thereby rebutting such a claim, Examiner has also not required Applicants to make a **provisional election** with respect to a **single species in the Markush Group** in claim 8, but has rather, mixed the Separately claimed Species in claim 4 (carbon dioxide) with the claimed Markush Group Species, thereby frustrating the examination guidelines.

Moreover, Examiner has stated that the alternative compounds "are independent and distinct because **all the species are separately able to clean the substrate by forming a supercritical fluid**" thereby directly contradicting the guidelines for restricting a Markush Group by establishing that the Species:

(1) share a
common utility, and

(2) share a substantial structural
feature disclosed as being essential to that utility.

U.S.S.N. 10/791,247

See also, Section 806.04(f) of the MPEP that requires the claims restricted to different species **be mutually exclusive:**

"Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species."

Thus, Examiner Restriction Requirement is fundamentally flawed in that 1) a prima facie case of an serious burden on Examiner has not been made or even asserted, preventing Applicant from rebutting such a claim, and 2) the guidelines for restriction of Markush type claims has not been followed, which is compounded by the grouping by Examiner of Markush claim Species with separately claimed Species, where Examiner himself **has established a common utility and a structural similarity essential to that utility**, thereby, while not admitting that such is the case, presenting the possibility that the Patent Office may be required to issue more than one Patent for a single

U.S.S.N. 10/791,247

invention.

Applicants respectfully urge Examiner to withdraw his restriction requirement and examine all the claimed supercritical fluid species as they are entitled to have done.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "Randy W. Tung", is written over a horizontal line. The signature is stylized with a large, circular loop at the beginning.

Randy W. Tung
Reg. No. 31,311